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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,701	04/01/2002	Yuko Kinoshita	02125/ HG	2708

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EXAMINER	
PRATT, HELEN F	

ART UNIT	PAPER NUMBER
1761	

DATE MAILED: 01/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Applicati n No.	Applicant(s)
	10/089,701	KINOSHITA ET AL.
	Examiner	Art Unit
	Helen F. Pratt	1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

P riod for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-55 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-55 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-55 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,387,425. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method makes the claimed composition as in instant claims, and the method of claims encompass those of the patent, and the further claims depend from these claims.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 4, 7, 8, 11, 12, 14, 20, 23, 26, 27, 30, 33, 34, 40, 41, 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coelho (Brazil 970414, XP 002158135) in view of Nakagawa (404108358 A).

Coelho discloses that it is known to remove potassium from juice by ionic (cation) exchange, with a reduction of the original pH. Calcium is added to return the juice to its original pH. Claims 4 and 23 differ from the reference reduction of the potassium content of the juice to not more than one-tenth and in the addition of an organic acid to the juice. However, nothing is seen that the method and composition of Coelho does not reduce the juice by one-tenth. Certainly, it would have been within the skill of the ordinary worker to repeat the process until the desired level of potassium was achieved. Therefore, it would have been obvious make a potassium composition with a reduce amount of potassium within the claimed amount.

Claim 8 further requires the addition of an organic acid to the low potassium juice. Nakagawa discloses that it is known to add organic acids such as citric and lactic to potassium chloride to remove the bitter taste. The bitter taste of the compound is generally attributed to the potassium. Therefore, it would have been obvious to add acids to other composition containing potassium to remove the bitter taste.

Claim 20 further requires that the juice content of potassium is no more than one twentieth. It would have been within the skill of the ordinary worker to make a juice with such a potassium content as shown by the above references because this involves replacing whatever amount of potassium is required as in Coelho. Therefore, it would have been obvious to use higher levels of potassium, as it is known how to achieve an

even lower level of potassium by replacement of potassium ions with calcium ions depending on the end product required.

The limitations of claims 23, 26, 27, 30, 33, 40, 41 and 42 have been discussed above and are obvious for those reasons.

The limitations of claims 1, 2, 7,14, 34, 37, 38, 39, 40 have been also disclosed above. These claims are also product by process claims. The fact that the procedures of the reference are different than that of applicant is not a sufficient reason for allowing the product-by-process claims since the patentability of such claims is based upon the product formed and not the method by which it was produced. See In re Thorpe 227 USPQ 964. The burden is upon applicant to submit objective evidence to support their position as to the product-by-process claims. See Ex parte Jungfer 18 USPQ 2D 1796. Therefore, it would have been obvious to make a product using the composition of the combined references.

Claim 11 further requires a freeze dried composition which would make a powder. However, juices are routinely freeze- dried and nothing new is seen in this. Therefore, it would have been obvious to freeze dry the composition.

The limitations of claim 12 has been disclosed above and are obvious for those reasons.

Claims 5, 9, 12, 21, 24, 28, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over the above reference as applied to the above claims, and further in view of Vorage et al. (6,274,105).

Nothing new is seen in the use of a column or batch type of process, as in the above claims, as the specification discloses that it is known to use ion exchange resins (page 2). Columns or batch type of treatments are routinely used as disclosed by Vorage et al. (col. 2, lines 17-20, and col. 4, lines 30-34, lines 55-60. Therefore, it would have been obvious to remove potassium using the claimed type of treatment.

Claims 15-18, 35, 36, 44-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over the above references as applied to the above claims, and further in view of Takao (4,855,159) and Givens, (page 1084).

Claims 15, 17, 35, 36, 44-55 further requires that the potassium food is in the form of a gel containing a gelling agents, a thickener and a carbohydrate. Givens discloses that it is known to make jelly with sugar lemon juice and pectin (thickener)(page 1084). The claims differ from the known art of jelly making in the use of a low potassium juice. Takoa et al. '159 discloses that it known to treat soybean milk by a process that removes 99.9% of the potassium from the soybean milk (col. 8, lines 48-55). The reference discloses that a jelly composition can be made from the potassium reduced milk and a thickener. The reference discloses the use of starch which is a carbohydrate (col. 7, lines 5-60). Therefore, it would have been obvious to use a juice having a low potassium content in a known jelly composition as shown by Givens.

Claim 16 and other similar claims further requires a particular method of making the jelly by hot filling, the composition in a soft container with a mouthpiece and a cap.

However, the claim is combining process limitations and apparatus limitations in a composition claim which are not given weight. See in re Thorpe, supra above. Therefore, it would have been obvious to make a composition as claimed as shown by the combined references.

Claims 17 and 18 further require a flavoring agent. However, nothing new is seen in adding flavoring agents. A natural flavoring agent is found in the various juices. Therefore, it would have been obvious to add flavoring agents to the composition for their known use.

Claims 19 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coelho in view of Nakagawa (404108358 A) as applied to the above claims, and further in view of XP 002158133 (JP 63296663).

Claim 19 further requires the use of the low potassium juice for patients suffering from kidney failure. XP 002158133 discloses that it is known to use ion exchange to reduce the levels of potassium (abstract) for patients having kidney disease. The claimed composition has been shown by Coelho in view of Nakagawa '358. Therefore, it would have been obvious to use a low potassium juice in the composition of the combined references for patients suffering from kidney failure.

Claim 43 further requires particular amounts of calcium to the composition. Nothing is seen at this time that the added calcium as in XP 002158135 would not have been within the claimed amount. Whether adding calcium as a pH modifier or as an additive, it would have been within the skill of the ordinary worker to add particular

amounts. Therefore, it would have been obvious to add enough calcium to perform a particular function.

Allowable Subject Matter

Claims 3, 6, 10, 13, 22, 25, 29, 32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and if a terminal disclaimer was submitted.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen F. Pratt whose telephone number is 571-272-0404. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Milton Cano, can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-0987.

Hp 1-10-04

H. Pratt

HELEN PRATT
PRIMARY EXAMINER